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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/484,838	06/07/1995	STEVEN F. FABIJANSKI	33229-324-PI	4954

27310 7590 07/15/2003

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[REDACTED] EXAMINER

FOX, DAVID T

ART UNIT	PAPER NUMBER
1638	37

DATE MAILED: 07/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)
	08/484,838	FABIJANSKI ET AL.
Examiner	Art Unit	
David T. Fox	1638	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 June 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) The period for reply expires 3 months from the mailing date of the final rejection.
- b) The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. The proposed amendment(s) will not be entered because:
 - (a) they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) they raise the issue of new matter (see Note below);
 - (c) they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. Applicant's reply has overcome the following rejection(s): _____.
4. Newly proposed or amended claim(s) ____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. The a) affidavit, b) exhibit, or c) request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
6. The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. For purposes of Appeal, the proposed amendment(s) a) will not be entered or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 13-16.

Claim(s) withdrawn from consideration: _____.

8. The proposed drawing correction filed on ____ is a) approved or b) disapproved by the Examiner.
9. Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
10. Other: claim objection overcome by amendment

Item 5 (continued). Applicants are thanked for clarifying the examined claims in the copending application.

Applicants urge that the double patenting rejection is improper, since the Examiner relied upon the specification which is forbidden per MPEP 804. The Examiner maintains that MPEP 804 prohibits the reliance upon the specification as prior art, but also states on page 22 of Chapter 800 of the August 2001 revision, column 2, penultimate paragraph, that “[t]his does not mean that one is precluded from all use of the patent disclosure.” See also the paragraph bridging pages 22 and 23 of Chapter 800, which states that

[t]hose portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in the application defines an obvious variation of an invention claimed in the patent....[O]ne can judge whether or not the invention claimed in an application is an obvious variation of an embodiment disclosed in the patent which provides support for the patent claim.

In the instant case, the Examiner was merely citing the portion of the patent specification to illustrate his assertion that the use of 3' transcription terminator signals is well-known in the art of plant transformation for heterologous gene expression, and was not invented by Applicants. The Examiner was not relying upon the patent specification for a teaching of such a transcription terminator signal which did not appear in the prior art. Even without the cumulative statements found in the patent specification, one of ordinary skill in the art would have recognized that the use of 3' transcription terminator sequences in plant transformation constructs is well-known in the art, so that their recitation in the instant claims would have been an obvious

variation over the patented or copending claims. Note also that the patented claims employ open language, and so do not exclude the presence of the well-known transcriptional terminator sequences.

See also *In re Kuhle*, 188 USPQ 7, (CCPA 1975), which teaches that a feature which solves no stated problem and which presents no unexpected results would have been an obvious matter of choice.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fox whose telephone number is (703) 308-0280. The examiner can normally be reached on Monday through Friday from 10:30AM to 7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached on (703) 306-3218. The fax phone number for this Group is (703) 872-9306. The after final fax phone number is (703) 872-9307.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

July 8, 2003

DAVID T. FOX
PRIMARY EXAMINER
GROUP 160-1638

David T. Fox